

Attorney Docket No.. 47487-0001-00-US (226811)

Application No.: 10/582,336

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REMARKS

Applicants respectfully request entry of the above amendments and reconsideration of the following arguments pursuant to 37 C.F.R. § 1.111.

1. Substitute Abstract and Substitute Specification

Applicants submit herewith (1) the Substitute Abstract, and (2) the Substitute Specification, in which Applicants replace each recited “wheat/barley” with “wheat or barley.” A clean copy of the Specification is also submitted herewith complying with the requirement of 37 C.F.R. § 1.125(c). Support for the amendments can be found at least, for example, from page 4, lines 11-13 of the Specification, and originally filed claim 10, which is presently canceled. Applicants believe that the filed Substitute Abstract and Substitute Specification contain no prohibited new matter.

2. Status of the Claims

Claims 1-23 stand pending. Claims 1-23 stand rejected. Claim 13 stands objected to.

Upon entry of the present amendments, claims 10, and 21-23 stand canceled. Claims 1-2 stand amended to incorporate elements from claim 22 and claim 21, respectively. Applicants further amend claims 3-9, 11-12, and 14-20 to more precisely recite the claimed subject matter.

Support for the amendments can be found at least, for example, from the originally presented claims, page 4, lines 11-13, and page 12, line 17 of the Specification. Applicants do not believe that the amendments add prohibited subject matter that is unsupported in the Specification as filed.

The claims have been amended without prejudice to, or disclaimer of, the canceled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendments.

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3. Acknowledgement of the Certified Priority Documents

Applicants note with appreciation the indication that the certified priority documents have been received in the present application.

4. Acknowledgement of Information Disclosure Statements

Applicants note with appreciation that the Office acknowledges the Information Disclosure Statements filed May 25, 2007 and June 6, 2006.

5. Claim Objection

The Office objects to claim 13, alleging that the term “otsurui shochu” allegedly is not defined in the claims. The Office interprets the term as “single distilled.” Office Action, page 2.

Applicants respectfully traverse the objection, because term definition in a claim is not required. U.S. patent law or rules do not require a claim element defined in the claims. An applicant is entitled to be his or her own lexicographer, as long as (1) the definition is reasonably clear, deliberate, and precise, and (2) if the definition is uncommon, it has been set forth in the disclosure so as to given a skilled artisan notice of the change in meaning. *See Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 U.S.P.Q.2d 1383, 1386 (Fed. Cir. 1992). Furthermore, the interpretation of a claim element must be “consistent with the specification, [] and claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *See In re Sneed*, 710 F.2d 1544, 1548, 218 U.S.P.Q. 385, 388 (Fed. Cir. 1983).

The term “shochu” is defined as “Japanese distilled liquor.” *See* page 4, lines 9-10 of the Specification. The term “otsu-rui shochu” is defined as “shochu produced by distilling an alcohol-containing material in a batch distiller, alcohol content ≤ 45%.” *See* page 11, lines 4-6 of the Specification. Given the definitions, Applicants respectfully request the Office to (1) withdraw the objection, and (2) interpret the term based on the definitions provided.

6. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph

The Office rejects claims 1-23 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Office alleges the claims are generally narrative and indefinite. Office Action, page 2. The Office alleges that (1) “mugi,” in the term “mugi shochu” recited in claim 11, means barley based on “a human Japanese translation,” and (2) “mugi shochu” is defined in claim 11 as “shochu distilled from wheat/barley.” Office Action, page 3. The Office further asserts that claim 10 defines “wheat/barley” as barley **OR** wheat. *Id.* The Office then concludes that “wheat/barley,” which is recited in each claim of the present application, is subject to multiple interpretations and thus indefinite. *Id.*

Applicant traverse. The inquiry for definiteness determination rests on whether those skilled in the art would understand the scope of the claim is read in light of the specification. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 U.S.P.Q.2d 1081, 1088 (Fed. Cir. 1986).

Applicants amend “wheat/barley” to “wheat or barley,” mootting this aspect of the rejection. The Office’s interpretation of “mugi” is inaccurate. In Japanese, “mugi” is a generic term referring to grains, such as wheat (“komugi”), barley (“oomugi”), and oats. *See Online Japanese Dictionary, available at* <http://jisho.org>. Applicants respectfully request withdrawal and allowance of the claims in view of the arguments and amendments.

The Office further rejects claim 9, alleging that the claim element “raw material alcohol” is unclear as to what is included or excluded. Office Action, page 3. Without acquiescing as to the merits of the rejection, claim 9 has been amended and no longer recites “raw material alcohol.” Accordingly, the indefiniteness rejection of claim 9 is moot. Applicants respectfully request withdrawal of the rejection and allowance of claim 9.

7. Rejection of the Claims Under 35 U.S.C. § 102(b)

7.1. Rejection of Claims 1-10, 16, and 23

The Office rejects claims 1-10, 16, and 23 under 35 U.S.C. § 102(b) as allegedly being anticipated by **Kitajima et al., Beer no Hanashi**, Gihodo Shuppan Co., Ltd., April 5, 1994, pp.

169-170 [hereinafter “Kitajima”] as evidenced by **Oono** (U.S. Published Application No. 2005/022095) [hereinafter “Oono”].

Kitajima allegedly teaches mixing various kinds of beers with liquors to make cocktails. Office Action, page 4. The “Dog’s Nose” cocktail allegedly comprises gin and cold black beer, while the “Boiler Maker” type of cocktail allegedly comprises whiskey, gin, aquavit, or shochu with beer as a chaser. *Id.* The Office alleges that (1) the beer of Kitajima corresponds to the presently recited component A as an alcohol-containing material made of wheat or barley and other starting materials; and (2) whiskey, gin, or shochu in Kitajima corresponds to the presently recited component B as distillates from grains such as wheat or barley. *Id.* The Office further alleges that:

- 1) the cocktail recipe for the “Dog’s Nose” or the “Boiler Maker” teaches a malt fermented beverage meeting the limitations of claims 1-6;
- 2) Kitajima anticipates claims 7-8 for using an alcohol-containing material having a malt content greater than 66.7%;
- 3) Kitajima anticipates claims 9-10 and 16 for disclosing whiskey, gin, or shochu as the component B; and
- 4) Kitajima anticipates the method recited in claim 23, which discloses mixing a beer and a distilled grain alcohol.

Office Action, pages 4-6. Oono is relied upon for its purported teaching that beer is classified to have a malt content greater than 66.7%. Office Action, page 5.

Applicants traverse the rejection to the extent it is applied to the amended claims. Prior art anticipates a claim only when it discloses each and every element of the claim explicitly or inherently. The fact that a certain property may be present in a prior art is insufficient to establish the inherency of such a property. *See In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

Claim 1 as amended recites, *inter alia*, a ratio between an alcohol content from the alcohol-containing material of the component A and an alcohol content from the alcohol-containing distillate of the component B is in a range of about 97.5:2.5 to about 90:10 [hereinafter “alcohol content ratio”]. Claim 2 as amended recites, *inter alia*, a volume ratio between the component A and the component B is in a range of about 99.9:0.1 to about 90:10 [hereinafter “volume ratio”]. In Kitajima, the receipt of “Dog’s Nose” discloses an unspecified volume of the cocktail containing 60 cc of gin, while the receipt of “Boiler Maker” does not

specify the volume of either whiskey or beer. Kitajima thus fails to disclose at least either recited ratio.

Claims 1-2 as amended are therefore novel over Kitajima, which fails to disclose each and every claim element. *See Rijckaert*, 9 F.3d at 1534, 28 U.S.P.Q.2d at 1957. Similarly, other claims are novel over Kitajima, because each of them incorporates the elements of claim 1 or 2. Furthermore, claims 10 and 23 stand canceled upon entry of the present amendments, mooting the rejection. Accordingly, Applications respectfully request withdrawal of the rejection and allowance of the claims.

7.2. Rejection of Claims 1-6, 9-15, and 21-23

The Office rejects claims 1-6, 9-15, and 21-23 under 35 U.S.C. § 102(b) as allegedly being anticipated by **Hoppy de Happy-to**, *Hoppy de Happy Dokuhon*, Kabushiki Kaisha Asupekuto, August 22, 2000, pp. 30-35 [herein after “Hoppy de Happy-to”] as evidenced by **Oono and Japanese Spirits** (<http://jal.com/it/shochu/whats/jshochu.html>) [hereinafter “Japanese Spirits”].

Hoppy de Happy-to allegedly discloses mixing 25-proof shochu with Hoppy, which is a lower alcohol containing fermented malt beer-like beverage, resulting a mixture with a soothing feeling. Office Action, pages 6-7. The Office further alleges that:

- 1) Hoppy de Happy-to anticipates claims 1-4 and 23, because Hoppy and shochu correspond to the recited component A and component B, respectively;
- 2) Hoppy de Happy-to anticipates claim 5, because it teaches the use of hops, which are known as bittering agents;
- 3) Hoppy qualifies as a sparkling malt liquor instead of beer, and it has a malt content lower than 66.7%;
- 4) Hoppy de Happy-to anticipates claims 9-11 and 14, because shochu is a known Japanese distilled liquor derived from grains such as barley or wheat;
- 5) Hoppy de Happy-to anticipates claims 12-13 and 15 as evidenced by Japanese Spirits; and
- 6) Hoppy de Happy-to teaches the recited ratios in claims 21-22.

Office Action, pages 7-10. Oono is relied upon for its purported teaching that beer is classified to have a malt content greater than 66.7%. Office Action, pages 7-8. Japanese Spirits is relied

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upon for its purported teaching that type-A shochu is distilled continuously, while type-B shochu is produced using traditional single or batch distillation. Office Action, page 8.

Applicants traverse the rejection to the extent it is applied to the amended claims, because the cited art fails to disclose each and every claim element. Claim 1 as amended recites, *inter alia*, an alcohol content ratio; and claim 2 as amended recites, *inter alia*, a volume ratio. See Section 7.1. *supra*. Hoppy de Happy-to allegedly teaches that Hoppy has an alcohol content of about 0.8%, while the 25-proof shochu has an alcohol content of about 12.5%. The mixed beverage allegedly has an alcohol content in the range of 3% to 8%. The 3% to 8% alcohol content range, upon conversion, indicates that an alcohol content ratio between Hoppy and 25-proof shochu is in the range of 21.7:78.3 to 3.9:96.1; and a volume ratio between Hoppy and 25-proof shochu is in the range of 81.2:18.8 to 38.5:61.5.¹ Neither of the two ranges overlaps with the presently recited ranges, *i.e.*, about 97.5:2.5 to about 90:10 (alcohol content ratio) and about 99.9:0.1 to about 90:10 (volume ratio). Accordingly, Hoppy de Happy-to fails to teach at least the recited ratios.

Claims 1-2 as amended are thus novel over Hoppy de Happy-to, because the cited art fails to disclose each and every claim element. *See Rijckaert*, 9 F.3d at 1534, 28 U.S.P.Q.2d at 1957. Similarly, other claims are novel over Hoppy de Happy-to, because each of them incorporates the elements of claim 1 or 2. Furthermore, claims 10 and 21-23 stand canceled upon entry of the present amendments, mooting the rejection. Accordingly, Applications respectfully request withdrawal of the rejection and allowance of the claims.

8. Rejection of the Claims Under 35 U.S.C. § 103(a)

8.1. Rejection of Claims 5, 11, 14, and 16-18

The Office rejects claims 5, 11, 14, and 16-18 under 35 U.S.C. § 103(a) as allegedly unpatentable over **Kitajima** or **Hoppy de Happy-to** as evidenced by **Brewing Techniques**:

¹ Volume ratio calculation: $81.2\% \times 0.8\% + 18.8\% \times 12.5\% = 3.0\%$; $38.5\% \times 0.8\% + 61.5\% \times 12.5\% = 8.0\%$. The calculation indicates that the mixture of Hoppy de Happy-to, containing 3% to 8% alcohol, will have a volume ratio in the range of 81.2:18.8 to 38.5:61.5 (Hoppy : 25-proof shochu). Alcohol content ratio calculation: $(81.2\% \times 0.8\%):(18.8\% \times 12.5\%) = 21.7:78.3$; $(38.5\% \times 0.8\%):(61.5\% \times 12.5\%) = 3.9:96.1$. The calculation indicates that the mixture of Hoppy de Happy-to, containing 3% to 8% alcohol, will have an alcohol content ratio in

Wheat Beer (http://www.brewingtechniques.com/library/styles/1_1style.html) [hereinafter “Brewing Techniques”].

The Office alleges that Kitajima and Hoppy de Happy-to (1) each teaches a malt fermented beverage encompassing claims 1-2; (2) both references teach claim 5, where the component A as a malt-fermented alcohol-containing material is made of at least malt, hops, and water; and (3) this information would have led a skilled artisan at the time to modify the alcohol-containing fermented malt material by including additional starting materials known in the art to result in a more robustly flavored beer-like product. Office Action, pages 10-11. Regarding claims 11, 14, and 16, the Office admits that neither Kitajima nor Hoppy de Happy-to discloses the wheat or barley origin of the recited shochu. Office Action, page 11. The Office, however, asserts that it would have been “*complimentary*” to have shochu from wheat or barley, solely because the fermented malt material is from wheat or barley. *Id.* The Office also admits that Kitajima does not teach that the malt content of component A is 100% and the component B is otsu-rui mugi shochu, as set forth in claim 17. Office Action, page 12. Kitajima allegedly teaches the generic use of beer and shochu. The Office asserts that beer has a malt content higher than 66.7% under Japanese Liquor Tax Law. *Id.* The Office then alleges that it would have been obvious to modify what was generally taught in Kitajima. *Id.* The Office relies on Brewing Techniques to assert that wheat beers have slightly less malt content, which is typically 40-60%. Office Action, page 13. The Office concludes that it would have been obvious to (1) substitute the black beer in Kitajima for the low-malt-content wheat beer, and (2) use a wheat derived shochu to *compliment* the use of a wheat beer, both of which are recited in claim 18. *Id.*

Applicants respectfully traverse the rejection to the extent it is applied to the amended claims. A finding of obviousness under 35 U.S.C. § 103 requires a determination of the scope and content of the prior art, the differences between the invention and the prior art, the level or ordinary skill in the art, and whether the differences are such that the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966); *KSR Int'l Co. v.*

the range of 21.7:78.3 to 3.9:96.1 (Hoppy : 25-proof shochu). Applicants provide the above calculation to demonstrate that Hoppy de Happy-to fails to disclose either recited ratio.

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Teleflex Inc., 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007). When determining whether a claim is obvious, the Office must make “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995). Further, “obviousness requires a suggestion of *all* limitations in a claim.” *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974) (emphasis added)). Once the scope and content of the prior art are determined, the relevant inquiry is whether the prior art suggests the invention, and whether one of ordinary skill in the art would have had a reasonable expectation that the claimed invention would be successful. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *Examination Guidelines for Determining Obviousness under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,528.

Claims 1-2 as amended recites an alcohol content ratio and a volume ratio, respectively. See Section 7.1. *supra*. Upon entry of the present amendments, each of the other pending claims depends upon claim 1 or 2, and incorporates either ratio limitation. The Office admits that Kitajima does not teach how much beer is mixed with the liquor. Office Action, page 14; Section 7.1. *supra*. Accordingly, Kitajima fails to suggest recited ratios. Brewing Techniques does not suggest the recited ratios either, because Brewing Techniques is relied upon for its purported teaching as to the malt content of wheat beers. Kitajima and Brewing Techniques, alone or viewed in combination, thus fail to teach or suggest at least the recited ratio elements. *CFMT*, 349 F.3d at 1342, 68 U.S.P.Q.2d at 1947.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. See page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. Neither Kitajima nor Brewing Techniques addresses the taste of alcohol-containing beverages. Kitajima and Brewing Techniques thus fail to provide an expectation that the combination would have yielded a beverage with crisp taste and robust feel as obtained in the presently claimed beverage.

Hoppy de Happy-to at best teaches (1) an alcohol content ratio between Hoppy and 25-proof shochu is in the range of 21.7:78.3 to 3.9:96.1, and (2) a volume ratio between Hoppy and 25-proof shochu is in the range of 81.2:18.8 to 38.5:61.5. *See Section 7.2. supra.* Each of the amended claims recites, between component A and component B, an alcohol content ratio of about 97.5:2.5 to about 90:10 or a volume ratio of about 99.9:0.1 to about 90:10. Hoppy de Happy-to fails to teach or suggest the recited ratios. Brewing Techniques does not teach the recited ratios either, because Brewing Techniques is relied upon for its purported teaching as to the malt content of wheat beers. Hoppy de Happy-to and Brewing Techniques, alone or viewed in combination, thus fail to teach or suggest at least the recited ratio elements. *CFMT*, 349 F.3d at 1342, 68 U.S.P.Q.2d at 1947.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification.* At best, Hoppy de Happy-to teaches a “soothing feeling” for the mixture of Hoppy and shochu. *See last paragraph on page 3 of Hoppy de Happy-to.* The “soothing feeling” is neither crisp taste nor robust feel. Additionally, Brewing Techniques fails to address the taste of alcohol-containing beverages. Hoppy de Happy-to and Brewing Techniques thus fail to provide an expectation that the combination would have yielded a beverage with crisp taste and robust feel as obtained in the presently claimed beverage.

Accordingly, amended claims are non-obvious over the cited art. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

8.2. Rejection of Claims 19-22

The Office rejects claims 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Kitajima** in view of **Hoppy de Happy-to**.

Regarding claims 19-20, the Office alleges that it would have been obvious for a skilled artisan to (1) substitute the beer taught in Kitajima with other beer-like sparkling beverage materials taught by Hoppy de Happy-to, and (2) use a low-malt material as the component A. Office Action, page 14. As to claim 21-22, the Office alleges that it would have been obvious

for a skilled artisan to modify the volumetric ratios of components A and B as taught by Kitajima. The Office further alleges that adjustment of volume is routine optimization. Office Action, pages 14-15.

Applicants respectfully traverse the rejection to the extent it is applied to the amended claims. Neither Kitajima nor Hoppy de Happy-to teaches or suggests the ratio element present in each of the presently amended claims. *See Section 8.1. supra.* Kitajima and Hoppy de Happy-to, alone or viewed in combination, thus fail to teach or suggest at least the recited ratio elements. *CFMT*, 349 F.3d at 1342, 68 U.S.P.Q.2d at 1947.

Furthermore, Applicants have discovered for the *first time* that mixing component A and component B with the recited ratios results in a beverage with refreshing finish, *i.e.*, crisp taste while ensuring robust feel. *See* page 2, line 22 through page 3, line 3, page 12, lines 9-17, and page 13, Table 1 of the Specification. At best, Hoppy de Happy-to teaches a “soothing feeling” for the mixture of Hoppy and shochu. *See* last paragraph on page 3 of Hoppy de Happy-to. The “soothing feeling” is neither crisp taste nor robust feel. Additionally, Kitajima fails to address the taste of alcohol-containing beverages. Hoppy de Happy-to and Kitajima thus fail to provide an expectation that the combination would have yielded a beverage with crisp taste and robust feel as obtained here.

Accordingly, amended claims are non-obvious over the cited art. Claim 21-22 stand canceled upon entry of the present amendments, mooting the rejection. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

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CONCLUSION

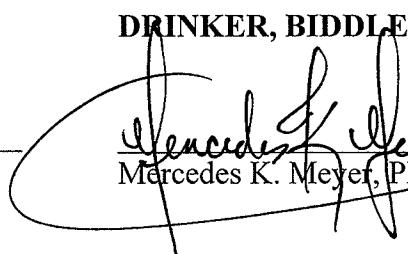
Should the Examiner have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8821. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

Dated: July 28, 2009


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